

PATENT APPLICATION

Our Docket No. 20020011.ORI

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re App : John Collinge et al : August 26, 2004
S.N. : 10/031,975 : Art Unit 1648
Filed : January 24, 2002 : Examiner Jeffrey Parkin
For : FRAGMENTS OF CELLULAR PRION
PROTEIN AND METHODS USEFUL
IN THE DIAGNOSIS AND TREATMENT
OF PRION DISEASES

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RESPONSE

Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This paper is submitted in response to an Official Action mailed July 27, 2004. That action was in the form of a Restriction Requirement and carried a shortened statutory period for response of one month making a reply due by August 27, 2004.

The Restriction Requirement indicated that the application contained some 17 different inventions or groups of inventions which were deemed to be not sufficiently linked as to form a single inventive concept under PCT Rule 13.1.

In accordance with the requirements of the Action, applicants elect the claims of Group I which include claims 31-33 and 64 drawn to PrP^c peptidic fragments corresponding to amino acids 176-221.

This election is made with traverse, particularly as to claims of Group II, IV and VI for reasons outlined below.

It should be noted that the claims of Groups II and IV refer to methods of using the defined peptide fragments of Group I to make polyclonal and monoclonal antibodies. The claims of Group VI define methods of using the defined peptide fragments of Group I to identify binding agents.

In this manner, the claims of Groups II, IV and VI all relate to methods which use the peptide fragments of Group I. The novelty and patentability of the claims of Groups II, IV and VI therefore also all relate to the novelty and patentability of the peptide fragments of Group I. It follows, therefore, that if the claims of Group I are found to be patentable, then the method claims in the Groups II, IV and VI should also be patentable such that no further search or examination would be required to reach this determination. It is submitted that this demonstrates that these claimed Groups are so linked as to form a single inventive concept.

The examiner is further referred to the requirements of PCT Rule 13.1 and PCT Applicant's Guide, Volume 1, Paragraph 131 which states that:

"The method for determining unity of invention contained in Rule 12 is construed as permitting in particular, the inclusion of any one of the following combinations of claims of different categories in the same international application:

(i) in addition to an independent claim for a given product, an independent claim for a process specifically adapted for the manufacture of said product, and an independent claim for a use of said product" (emphasis added).

In view of the above, it is submitted that at least the subject matter of Groups II, IV and VI are so closely related to the products claimed in the claims of Group I, and are so linked as to

form a single inventive concept under PCT Rule 13.1. The claims of Group I therefore meet the test explicitly set up by the Examiner in the first paragraph of the Restriction Requirement.

Reconsideration of the Restriction Requirement and the rejoinder of at least Groups I, II, IV and VI is respectfully requested.

Respectfully submitted,

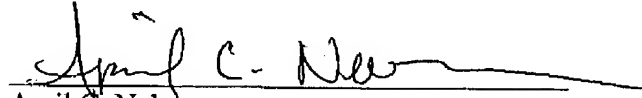
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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Response in response to the Official Action of July 27, 2004, in application Serial No. 10/031,975, filed on January 24, 2002, of John Collinge, et al. entitled "FRAGMENTS OF CELLULAR PRION PROTEIN AND METHODS USEFUL IN THE DIAGNOSIS AND TREATMENT OF PRION DISEASES", is being sent by facsimile transmission to: Examiner Jeffrey Parkin, Art Unit 1648, Commissioner for Patents, P.O. BOX 1450, Alexandria, VA 22313-1450 on 26 August 2004, facsimile No. 703-308-7722.



April C. Nelson

On behalf of C. G. Mersereau

Date of Signature: August 26, 2004